

Appl. No. : 09/618,766
Filed : July 18, 2000

REMARKS

Applicant has the following comments in response to the Office Action.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1-3, 5, 10, 11, and 15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,974,547, to Klimenko (hereinafter "Klimenko") in view of U.S. Patent No. 6,487,601, to Hubacher, et al. (hereinafter "Hubacher"). Claims 4, 7-9, 12-14, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Klimenko in view of Hubacher and further in view of U.S. Patent No. 6,473,855, to Welder (hereinafter "Welder"). Claims 6 and 16 were rejected under 35 U.S.C. § 103(a) as being over Klimenko in view of Hubacher and further in view of U.S. Patent No. 6,594,682, Peterson, et al. (hereinafter "Peterson").

One embodiment of Applicant's system is generally directed to a content delivery service. In one embodiment, executable code in a disk controller circuit in a disk drive is manufactured so as to, under the occurrence of a selected condition, initiate execution of a server-contacting program. The disk controller circuit may delay the initiation of the execution of the server contacting program until a predetermined period has lapsed or, alternatively, it may count the number of times a personal computer associated with the disk drive has been booted. After execution, the server-contacting program uses a network address that is stored in the disk drive to contact a content delivery server. The content delivery server then delivers content to the personal computer.

Claims 1 and 10

Turning to the claims, it is seen that independent Claim 1, as amended, recites "installing *disk drive executable code in a disk controller circuit in the disk drive to initiate execution* of the server contacting program after the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contacting program includes using the network address for connecting the personal computer system to the content delivery server." Independent Claim 10 recites "*a disk controller circuit for, upon the occurrence of a selected*

Appl. No. : 09/618,766
Filed : July 18, 2000

condition that is determined by the disk controller circuit, *initiating execution of the server-contacting program* after the disk drive is connected to the computing subsystem in the personal computer.”

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* M.P.E.P § 2143.03. Applicant respectfully submits that the cited references fail to teach or suggest in isolation or in combination at least one limitation from each of independent Claims 1 and 10. In the Office Action, the Examiner acknowledged that Klimenko fails to teach or suggest “installing disk drive executable code in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contact program includes using the network address for connecting the personal computer system to the content delivery server.” In the Office Action, the Examiner stated that this limitation was described in Hubacher. *See* Office Action, p. 4.

The section of Hubacher that was relied upon by the Examiner is set forth below:

The first part of the process is to set up the capability for remote booting. In the preferred embodiment, a set of programs at the workstation allows a remote boot and interaction with a program on the server. Instructions from a Basic Input Output System (BIOS) ROM are executed to load a Boot Code Loader (BCL) from a nonvolatile, read/write memory, such as a diskette or hard disk. The BCL executes to load a Remote Control Program (RCP), and the RCP executes to load a message program, a protocol manager and/or device drivers without loading an operating system. The message program and/or device drivers communicate with a Dynamic Mac Allocation and Configuration (DMAC) program in the network server. First, the program will interface with an NDIS compliant Network Interface Card (NIC) to send out a DMAC discovery frame. At this point the workstation seeks MAC specific information. The discovery frame will be intercepted by a DMAC program installed on the server which will be running and listening for the request. Once the DMAC program intercepts the request it will analyze the request and take one of two actions.

See Hubacher, col. 2, line 46-67. Applicant respectfully submits that the cited section is directed to a client computer loading a program, i.e., the Boot Code Loader (BCL), from a disk and running the BCL on the client computer. Applicant respectfully submits that the BCL is *not* executed in the disk drive. In contrast, Claim 1 recites “installing *disk drive executable code in a disk controller circuit in the disk drive to initiate execution* of the server contacting program after

Appl. No. : 09/618,766
Filed : July 18, 2000

the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contacting program includes using the network address for connecting the personal computer system to the content delivery server.”

Since the cited references fail to teach or suggest at least the above-limitations, Applicant respectfully submits that independent Claims 1 and 10 are in condition for immediate allowance.

Claims 2-9 and 11-17

Since Claims 2-9 and 11-17 each depend on one of Claims 1 and 10, Applicant respectfully submits that these claims are allowable for at least the reasons discussed above and the subject matter of their own limitations.


Summary

Applicant has endeavored to address all of the Examiner’s concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/3/2004

By: 
Eric M. Nelson
Registration No. 43,829
Attorney of Record
Customer No. 20,995
(619) 235-8550

S:\DOCS\EMN\EMN-4698.DOC
060304

Appl. No. : **09/618,766**
Filed : **July 18, 2000**

SUMMARY OF INTERVIEW

Applicant's attorney wishes to express his appreciation to the Examiner for the courtesy of conducting a telephonic interview for this application on May 26, 2004. During this interview, the Applicant and the Examiner discussed a proposed amendment to independent Claim 1 that when entered would overcome the current rejection. Furthermore, it was discussed that independent Claim 10 in its current form is patentable over the cited prior art. If the Examiner has any further questions regarding this response or otherwise, he is encouraged to contact the undersigned directly.